

7 Rep. for
Docket No. 1046.1133/GPJ

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Makoto YOSHIOKA, et al.

Group Art Unit: 3642

Serial No.: 08/645,073

Examiner: B. GREGORY

Filed: May 13, 1996

For: CONTENT SALES PERIOD VERIFYING SYSTEM AND CONTENT
DECRYPTION KEY EFFECTIVE PERIOD VERIFYING SYSTEM

COMMUNICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

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GROUP 2200

Sir:

This Communication requests withdrawal of the finality of the outstanding Office Action, issued March 9, 1998, for the reasons set forth below.

If you will recall, the initial Office Action, issued September 17, 1997, rejected claims 1-9 under 35 U.S.C. §112, second paragraph. No rejections under 35 U.S.C. §102 or 35 U.S.C. §103 were set forth in the initial Office Action.

In response thereto, Applicants amended claims 1-9 while presenting new claims 10-14. Taking claim 1 as a representative amended claim, a major revision thereto comprised amending: "sales period reading means for reading sales period said on the content;" to

--period reading means for reading a period stored on a
content medium indicating a period of time during which a
content on the content medium can be served--.

The remaining changes to claim 1 were by and large, cosmetic.

The limitation added into the period reading means in claim 1 was a limitation that was inherent in the term "sales period" and also more specifically set forth in

other claims such as claims 3, 5, 6 and 8. Accordingly, the amendments to claim 1 did not significantly alter the scope of claim 1, nor did they include major new limitations thereto.

The outstanding Office Action issued March 9, 1998 withdrew all of the previous rejections under 35 U.S.C. §112, indicating that the Applicants' amendments were thoroughly responsive thereto, while introducing rejections under 35 U.S.C. §102.

Applicants respectfully submit that the Examiner has made the outstanding Office Action final prematurely, in that he is rejecting the amended claims on grounds which should have been presented in the previous Office Action. Applicants believe that perhaps the Examiner has obtained an increased understanding of the invention, as opposed to the claims now claiming different subject matter. It is this increased understanding of the invention which has lead to the new prior art rejections.

The vast bulk of the physical amendments were in response to the Examiner's rejections under 35 U.S.C. §112. Accordingly, such rejections should have been reasonably expected. For example, looking at the initial Office Action, the Examiner states that the term "effective period" is unclear. Accordingly, the amendments to claim 1 and the other amendments defined the term period so as to be adequately clear, as evidenced by the Examiner's withdrawal of this rejection.

Applicants also respectfully submit that the policy goals met by "finality" are not applicable in the present case. Specifically, the use of a final Office Action is meant to bring prosecution to as speedy as conclusion as possible and at the same time to deal justly with both the Applicant and the public. See, MPEP 706.07. This is for the goal of reaching a clear issue prior to issuing a final rejection. Switching from one set of references (in this case no references) to another by the Examiner in rejecting in successive action claims having **substantially the same subject matter** will tend to defeat obtaining the goal. *Id.* An Applicant who is seeking to define his or her

invention and claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner that end, and not be prematurely cut-off in the prosecution of his or her case. Id.

Applicants respectfully submit that the subject matter of at least claim 1 is substantially the same as filed. While there may be differences in the wording, the subject matter is substantially the same. Further, in light of the fact that no previous prior art rejection was issued, Applicants reviewed the references as cited by the Examiner and provided amendments in conformity therewith to achieve claims which they believed they were justly entitled to.

Accordingly, Applicants respectfully request the Examiner withdraw the finality of the outstanding Office Action as the Examiner is rejecting claims of substantially the same subject matter based upon newly cited references; the majority of the amendments to the claims were merely responsive to the previous rejection under 35 U.S.C. §112 which the Examiner agrees has been overcome; and the finality goes against the policies of the U.S. Patent and Trademark Office.

Respectfully submitted,

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